

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEVEN J. WYGANT

Appeal 2007-3303
Application 10/789,078
Technology Center 3600

Decided: November 27, 2007

Before MURRIEL E. CRAWFORD, LINDA E. HORNER, and
BIBHU R. MOHANTY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellant seeks our review under 35 U.S.C. § 134 of the final rejection of claims 1-15, 17-18, and 20-22. Claims 16, 19, and 23 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b) (2002). We AFFIRM.

THE INVENTION

The Appellant's claimed invention is directed to a pneumatic shooting device. The shooting device includes a barrel and an action having a housing defining a pressure reservoir with a discharge outlet connected to the barrel. (Specification, 3: 6-8.) Claim 1, reproduced below is representative of the subject matter of appeal.

1. A pneumatic shooting device, comprising:

a barrel; and

an action including a housing defining a pressure reservoir with a discharge outlet connected to and approximately collinear with said barrel, a linear bearing body coupled with said housing, and a piston having a discharge end, said piston being slidably movable within said linear bearing body to selectively open and close said discharge outlet.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Schneider 5,769,066 June 23, 1998

Salva 2004/0200466 A1 October 14, 2004

The following rejections are before us for review:

1. Claims 1-5, 7-9, 12-14, 17-18, and 20-22 are rejected under 35 U.S.C. § 102(b) as anticipated by Schneider.

2. Claims 6 is rejected under 35 U.S.C. § 103(a) as unpatentable over Schneider in view of Salva.

3. Claims 10-11 and 15 are rejected under 35 U.S.C. § 103(a) as unpatentable over Schneider.

THE ISSUE

The Appellant argues that the Examiner erred in rejecting the claims 1-5, 7-9, 12-14, 17-18, and 20-22 under 35 U.S.C. § 102(b) as anticipated by Schneider.

This first issue is whether Schneider discloses “a pressure reservoir with a discharge outlet connected to and approximately collinear with said barrel.”

This second issue is whether Schneider discloses “a piston being slidably movable within said linear bearing body to selectively open and close said discharge outlet.”

FINDINGS OF FACT

We find the following enumerated findings of fact are supported at least by a preponderance of the evidence¹:

1. Schneider shows a pneumatic shooting device with a barrel (72) (Figure 6).

¹ See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) explaining the general evidentiary standard for proceedings before the Patent Office.

2. Schneider shows a housing (12) with an air reservoir (109), a longitudinal bore (21) collinear with the gun barrel, piston sleeve (32), and piston (40) (Figures 6 and 22.)
3. *Webster's New World Dictionary, Third College Edition* (1988), lists the primary definition of outlet as: 1) a passage or vent for letting something out.
4. Schneider's air reservoir (109) is vented when first radial vents (26) momentarily align with second radial vents (18). In this position the longitudinal bore (21) being previously sealed, receives the accumulated gas charge within air reservoir (109) (Col. 5:48-57).
5. Schneider's bore (21) serves as a "discharge outlet" for the air reservoir (109) since gas is vented to this bore.
6. Schneider piston (40) moves air control spool (20) in the direction of the arrow as seen in Figures 22-23 (Col. 5:28-43).

PRINCIPLES OF LAW

Principles of Law Relating to Anticipation

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, (Fed. Cir. 1987). Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim. We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction in light of the specification as it would be

interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). The properly interpreted claim must then be compared with the prior art.

"[A] prima facie case of anticipation [may be] based on inherency." *In re King*, 801 F.2d 1324, 1327 (Fed. Cir. 1986). Once a prima facie case of anticipation has been established, the burden shifts to the Appellant to prove that the prior art product does not necessarily or inherently possess the characteristics of the claimed product. *In re Best*, 562 F.2d 1252, 1255 (CCPA 1977) ("Where, as here, the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product."). See also *In re Spada*, 911 F.2d 705, 708-09 (Fed. Cir. 1990).

Principles of Law Relating to Obviousness

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called

secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, (1966). *See also KSR*, 127 S.Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [Graham] factors continue to define the inquiry that controls.”)

ANALYSIS

The Appellant argues that claim 1 is not anticipated because, “The discharge outlet of Schneider is defined as a radial vent ..., which defines the outlet as being perpendicular to the barrel. The Examiner has defined a housing with a discharge outlet, while Appellant has claimed a discharge outlet from the pressure reservoir.” (Reply Br. 5:9-12). The Appellant also argues, “The circuitous route of the radial vents, is simply not the structure claimed by the present invention...” (Br. 13:10-11).

We disagree. In Schneider’s device the air reservoir (109) serves as a pressure reservoir since it stores gas (FF 4). The accumulated gas is vented to bore (21) from the air reservoir (109) after traveling through the radial vents (FF 4). Giving the term “outlet” it broadest reasonable interpretation in view of the Specification, we determine that the bore (21) may be considered an “outlet” since the gas is eventually vented there (FF 4). Schneider’s bore or “outlet” (21) is collinear with the gun barrel (31) as required by claim 1 (FF 2). There is no requirement in the claim that the vented gas cannot travel perpendicularly, circuitously, or in any other direction, before being vented to the outlet which is collinear to the barrel. As noted in the Examiner’s Answer, the use of the term “comprising” does not exclude other elements from the claim (Ans. 10:3-5). The Specification

does not provide a definition of “outlet” that is inconsistent with our definition, and we decline to read a specific embodiment of an outlet from the detailed description into the rejected claims.

The Appellant also argues Schneider does not disclose that the “piston is slideable so as to selectively open and close the discharge outlet of the pressure reservoir” (Reply Br. 5:22-23). The Appellant further argues that only the radial vents 26 are closed or opened, not the discharge outlet (Reply Br. 6:1-3).

We disagree. When the piston (40) moves air control spool (20), gas is vented from the pressure reservoir (109) to the radial vents, and then to the discharge outlet (21) (FF 3-5). The motion of the piston (40) controls whether or not the bore (or “discharge outlet”) (21) is opened to the pressure reservoir (109).

The Appellants arguments for claims 6, 10-11, 15, and 21-22 are the same as relied on for claim 1 and are unpersuasive for the reasons given above.

CONCLUSIONS OF LAW

We find that the Appellant has failed to show that the Examiner erred in rejecting claims 1-5, 7-9, 12-14, 17-18, and 20-22 are rejected under 35 U.S.C. § 102(b) as anticipated by Schneider.

We find that the Appellant has also failed to show that the Examiner erred in rejecting claim 6 under 35 U.S.C. § 103(a) as unpatentable over Schneider in view of Salva, and claims 10-11 and 15 as unpatentable over Schneider.

DECISON

The decision of the Examiner to reject claims 1-15, 17-18, and 20-22 is AFFIRMED.

AFFIRMED

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

vsh

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